

REMARKS

Claims 1-6, 8-12, 14-16, 18-102, 132-146, 148-155 and 181-208 were pending in the present application. Claims 84-86 have been rejected and claims 1-6, 8-12, 14-16, 18-83, 87-102, 132-146, 148-152 and 181-208 have been allowed. Claims 153-155 were previously withdrawn from consideration. By virtue of this response, claims 84-86, 153-155, and 197-200 are cancelled. Accordingly, claims 1-6, 8-12, 14-16, 18-83, 87-102, 132-146, 148-152, 181-196, and 201-208 are currently under consideration. Allowance of the pending claims is respectfully requested.

With respect to all amendments and cancelled claims, Applicant has not dedicated or abandoned any unclaimed subject matter and, moreover, has not acquiesced to any rejections and/or objections made by the Patent Office. Applicant reserves the right to pursue prosecution of any presently excluded claim embodiments in future continuation and/or divisional applications.

Interview Summary

A telephonic interview with Examiner Whisenant was held on August 28, 2006. In addition to Examiner Whisenant and Alicia Hager (the undersigned), Gladys Monroy, Michael Cronin, and Ravinder Dhallan participated in the interview. Applicant and his representatives would again like to thank Examiner Whisenant for the courtesy of the telephonic interview.

The subject of the telephonic interview was the Office Action dated March 17, 2006, and the arguments in Applicant's response filed July 14, 2006. The independent claims, as amended by the response filed July 14, 2006, were discussed. In addition, some of the prior art cited in the Office Action dated March 17, 2006 was discussed in a general manner.

Applicant respectfully disagrees with the accuracy of the following statement in the Office's Interview Summary: "They also stressed that Claims 58, 87 and 152 was [*sic*] directed towards the isolation and analyse [*sic*] free fetal DNA [i.e. extracellular DNA derived from the fetus and present in a sample taken from a pregnant females [*sic*] (e.g.blood)]." As a general matter, "free fetal DNA" encompasses, but is not necessarily limited to, "extracellular DNA derived from

the fetus and present in a sample taken from a pregnant female.” Further clarification regarding claims 58, 87, and 152 is provided below.

The sample in claim 58 is a “sample comprising free fetal DNA, wherein an agent that inhibits cell lysis has been added to said sample to inhibit lysis of cells, if cells are present.” Claim 58 does not require that the sample comprising free fetal DNA need necessarily be limited to a sample taken from a pregnant female, although the “sample comprising free fetal DNA” encompasses such a sample. Claim 58 also does not require isolation of the free fetal DNA.

Furthermore, the nucleic acid that is isolated in claim 87 is “free nucleic acid from a sample that contains nucleic acid, wherein an agent that inhibits cell lysis has been added to the sample to inhibit lysis of cells, if cells are present.” Accordingly, the nucleic acid isolated in the method of claim 87 encompasses, but is not necessarily limited to, either fetal DNA or nucleic acid present in a sample taken from a pregnant female. Also, claim 87 does not require analysis of the nucleic acid.

Claim 152 is directed to a method for detecting the presence or absence of a fetal chromosomal abnormality, wherein the template DNA comprises a mixture of fetal DNA and maternal DNA, and wherein the template DNA is from a sample from a pregnant female. The fetal DNA in claim 152 encompasses, but is not necessarily limited to, free fetal DNA. In addition, Applicant notes that claim 152 makes no reference to a cell lysis inhibitor or to isolation of DNA.

Claim Amendments

Claims 84-86, 153-155, and 197-200 are cancelled without prejudice. No new claims are added and no claims are amended. No new matter is added by the amendments to the claims.

Claim Rejections under 35 U.S.C. § 103

The Office has rejected claims 84-86 as being unpatentable over Jones et al. [US 2003/0082576 (May 2003)] or Shapero et al. [Genome Research 11:1926-1934 (2001)] in view of Lagona et al. [Human Genetics 102:687-690 (1998)].

Without acquiescing to the arguments made by the Office regarding claims 84-86 or the cited references, and in the interest of expediting prosecution, claims 84-86 are cancelled. Accordingly, the rejection of claims 84-86 under 35 U.S.C. § 103 is moot.

Allowed Claims

Claims 1-6, 8-12, 14-16, 18-83, 87-102, 132-146, 148-155 and 181-208 are deemed allowable. Applicant would like to thank the Examiner for allowance of these claims.

Supplemental Information Disclosure Statement filed on February 9, 2005

A Supplemental Information Disclosure Statement and Form PTO/SB/08 were filed on February 9, 2005. A copy of the initialed Form PTO/SB/08 was not included with the Non-Final Office Action mailed March 17, 2006. Therefore, we respectfully request the Examiner to provide us with a copy of the initialed Form PTO/SB/08 for the Supplemental Information Disclosure Statement filed on February 9, 2005.

Two Supplemental Information Disclosure Statements filed on October 10, 2006

Two Supplemental Information Disclosure Statements and Form PTO/SB/08s were filed on October 10, 2006. We respectfully request the Examiner provide us with copies of the initialed Form PTO/SB/08s for the two Supplemental Information Disclosure Statements filed on October 10, 2006.

CONCLUSION

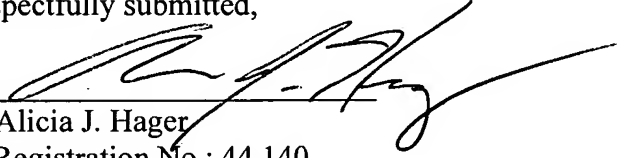
In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, Applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket no. **543312000420**. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Dated: December 12, 2006

Respectfully submitted,

By


Alicia J. Hager

Registration No.: 44,140

MORRISON & FOERSTER LLP
755 Page Mill Road
Palo Alto, California 94304-1018
(650) 813-4296